

REMARKS

Claim 12 has been canceled. Therefore, claims 1-9 and 11 are currently pending in this application.

Summary of Interview

Applicants' attorney thanks Examiner Bibbins for her time, and for the courtesy she extended during a telephonic interview on April 9, 2007. The Declaration of Mr. Horai filed on December 7, 2006 was discussed during the interview, with a particular focus on whether all co-inventors were required to sign a declaration filed under 37 C.F.R. 1.131. As Applicants' attorney explained during the telephone interview, the research and development group to which the inventors belonged has been closed, and that section of the company does not currently exist. Three of the four inventors still work for the company in different departments, and these three inventors were located and have provided a joint Declaration, which is attached. One of the four inventors has left the company and could not be located. This fact is also stated in a separate Declaration provided by one of the inventors.

Accordingly, as the Examiner requested and as discussed during the telephone conference, an attempt has been made to locate all inventors, and those inventors which are still employed by the company were located and they have signed a joint Declaration. In addition, a statement has been made by one of the inventors that the non-signing inventor has left the company, and is therefore not an employee of the company and could not be located. Accordingly, the Declaration should be accepted and entered into the record to remove the prior art reference.

Objections Based on Informalities

The Office has objected to claims 12 as depending from previously canceled claim 10. Applicants have canceled claim 12. Applicants respectfully request that the Office withdraw its objection.

35 U.S.C. § 102 Rejections

Claims 1-19 were rejected under 102(e) by Shirota et al. (US PGPub 2003/0067857) (hereinafter, "Shirota et al.").

Applicants respectfully traverse this ground for rejection. As discussed in detail in Applicants' Amendment dated December 7, 2006, it is Applicants' position that Shirota et al. is not prior art to the present application. In particular, Shirota et al., was published on April 10, 2003 for an application filed in the United States on September 10, 2002. The other reference cited by the Examiner, Usami et al., was published on September 11, 2003 for an application filed in the United States on March 6, 2003. Based on a Declaration filed herewith and executed by three of the four co-inventors of this application, the invention of the current application was reduced to practice on or before July 12, 2002, a date that is prior to the earliest filing date of either of the two references.

Applicants are enclosing herewith an executed Declaration under 37 C.F.R. 1.131 by three of the four co-inventors, including Takashi Horai, Narutoshi Fukuzawa, and Syuji Tsukamoto. In addition, Applicants are enclosing herewith an executed Supplemental Declaration under 37 C.F.R. 1.131 by the lead inventor, Takashi Horai.

The Supplemental Declaration of Mr. Horai states that he has located two of the other three co-inventors for purposes of signing the Declaration under 37 C.F.R. 1.31 enclosed herewith. In addition, Mr. Horai states that Hiroyuki Arioka, the fourth of the co-inventors, has resigned from TDK Corporation and that he could not be located for purposes of signing the Declaration.

The Declaration of Messrs. Horai, Fukuzawa, and Tsukamoto provides evidence that the invention was reduced to practice on or before July 12, 2002, prior to the earliest filing date of either of the two references. In addition, the declarants further state that Hiroyuki Arioka has resigned from TDK Corporation and could not be located for purposes of signing this Declaration.

In particular, the Declaration of Messrs. Horai, Fukuzawa, and Tsukamoto provides additional evidence and personal testimony of an actual reduction to practice prior to the September 10, 2002 filing date of Shirota et al. The Declaration expressly states that the

inventors had conceived of and reduced the invention to practice prior to September 10, 2002. As evidence that the invention had been reduced to practice prior to September 10, 2002, Messrs. Horai, Fukuzawa, and Tsukamoto attach Exhibit A which is a copy of two pages evidencing a reduction to practice of the invention.

These pages of Exhibit A are in Japanese. Accordingly, Applicants' attorney has had a Japanese interpreter provide a translation of the relevant portions for the Examiner. Attached to the response to this Office Action under the heading "Translation of Marked Text Portions" is provided a translation of those portions for ease of reference in the response. Looking now at Exhibit A of the Declaration, the graph at the top shows the basic pattern of a write pulse for a DVD at 4x speed. Since this is in English, no translation need be provided. The next heading, in Japanese, within Box #1 states that this paper depicts a strategy proposed for 4x DVD-R recordings.

On this paper, the inventors set forth the current state of the art and then provide examples of the practice of the invention having been carried out.

Specifically, Exhibit A to the Declaration has two pages: a first page in which one example is shown and a second page in which further practicing of the invention was conducted showing three total examples, the original first example and then two new examples of practicing the invention.

As Messrs. Horai, Fukuzawa, and Tsukamoto point out in the Declaration, the present invention provides greater margins for jitter that can be obtained using a longer T_{top} and a larger Ph/Pm ratio, which is obtained by using a smaller Pm value. *See, for example*, the text translation in Box #2 of Exhibit A, pages 1 and 2. (In the Japanese language text, the letters Ph was used for the top recording power, whereas the letters Pw were used in the present claims.)

As pointed out in the Declaration, and as is clear from the text of the contemporary document, the conditions for recording were set to be within the limit of the current claims of the application. Namely, the conditions were set so that the top recording power was greater than $1.7T$ and the ratio of Pw to Pm was greater than 1.4. This is currently reflected in all independent claims, namely, claims 1 and 7.

The rest of the Declaration is clear that the inventors actually conducted the test and achieved a reduction to practice and provided three examples on page 2 of Exhibit A of the Declaration.

The correlation between Exhibit A showing the reduction to practice of the invention and the present application can be seen in that the actual working examples as used in the patent application as filed in the U.S. on pages 23 and 24 are the actual working examples from this document of Examples #1, #2 and #3 in the table of Examples. Namely, the working examples which the Applicants provided in their application as filed in the U.S. are taken from and correspond to the examples of Exhibit A, page 2, which was created by the inventors evidencing a reduction to practice of the invention prior to the filing date of Shirota et al.

In conclusion, the Declaration of Messrs. Horai, Fukuzawa, and Tsukamoto, the Supplemental Declaration of Mr. Horai, together the attached contemporaneous documents clearly show a reduction to practice of the invention prior to the filing date of Shirota et al. of September 10, 2002. Accordingly, Shirota et al. is removed as a reference.

35 U.S.C. § 103 Rejections

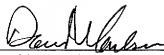
Claims 11 and 12 stand rejected under 103(a) as being unpatentable over Shirota et al. in view of Usami et al. (US PGPub 2003/0169679) (hereinafter "Usami et al.").

Applicants respectfully traverse this ground for rejection, as well. Usami et al. is also pre-dated by the Declaration of Messrs. Horai, Fukuzawa, and Tsukamoto. In particular, Usami et al. has a U.S. filing date of March 6, 2003. As discussed above, the Declaration of Messrs. Horai, Fukuzawa, and Tsukamoto shows a reduction or practice on or before July 12, 2002, a date that is prior to the March 6, 2003 filing date of Usami et al. Accordingly, Usami et al. is removed as a reference.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
SEED Intellectual Property Law Group PLLC



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Enclosures:

Translation of Marked Text Portions of Exhibit A
131 Declaration of Takashi Horai, Narutoshi Fukuzawa, and Syuji Tsukamoto
Exhibit A
Supplemental 131 Declaration of Takashi Horai

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